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EXAMINER

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ART UNIT PAPER NUMBER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

Application Number: 09/179,405
Filing Date: October 27, 1998
Appellant(s): KIM ET AL.

John H Stowe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 13, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant does not provide reasons in support thereof. Appellant basically states that "claim 8 is deemed to be patentable at least for reasons set forth above regarding claim 1" and "claim 14 is deemed to be patentable at least for similar reasons set forth above regarding claim 1".

The claims, therefore, should stand or fall together with claim 1.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|-----------|-----------------|--------|
| 6,091,808 | WOOD ET AL. | 7-2000 |
| 5,764,736 | SHACHAR ET AL. | 6-1998 |
| 6,192,044 | MACK | 2-2001 |
| 6,178,183 | BUSKIRK, JR. | 1-2001 |
| 5,982,774 | FOLADARE ET AL. | 9-1999 |
| 5,884,032 | BATEMAN ET AL. | 3-1999 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 – 19 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 7 and repeated below:

Claims 1 – 16, and 18 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,091,808 (Wood et al.) in view of U.S. Patent No. 5,764,736 (Shachar et al.).

With respect to claim 1, Wood et al teach a number searching system comprising: a phone (10); a telephone number database (42); a web server (34); an information terminal 12 (see Col. 3, lines 49 - 55) which displays a search for telephone

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number (see Fig. 3, element 68) and a telephone plug-in which automatically dials the displayed number (Compare page 6, lines 6 - 13 of the present application with Col. 6, line 56 - Col. 7, line 5 of Wood et al.).

The examiner notes Wood et al teach (col. 6, line 56 - col.7, line 9) that:

"On clicking the DIAL button 75 [Fig. 3], the web page manager 36 communicates a message, containing ... a called telephone number DN from the windows 68 [Fig. 3]... to the call control interface 46, via which this message is forwarded.... to the telephone switch 16. The switch 16 checks validity of the telephone numbers and that the subscriber's telephone 10 (calling telephone number CN) is on-hook, and provides a (possibly distinctive) ringing signal to the telephone 10. The subscriber, expecting this ring signal, takes his telephone 10 off-hook, and this is detected by the telephone switch 16 in conventional manner, in response to which the switch 16 sets up the desired telephone connection to the called number DN in the same manner as if the number DN had been dialed by the subscriber at the telephone 10." [Emphasis added]. When the subscriber at the telephone 10 dials a called directory number DN, the telephone switch 16 connects the call to the dialed DN independent of the web facility 22/web server 34 ("normal telephone call").

On one hand, clicking the dial button 75, as described above, may be read as the claimed "plug-in" having the ability to set-up the communication channel. On the other hand, since the Wood et al reference does not specifically use the exact term "plug-in", Examiner provided the Shachar reference which explicitly teaches the use of a "plug-in"

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to set-up a communication channel (Shachar, col. 5, line 60 - col. 6, line 27). The communication channel in Wood et al is set-up using "a personal computer executing browsing software" (Wood et al, Col. 3, lines 58-64). Thus, it would have been more than obvious to use a "plug-in" function as taught by Shachar in the personal computer of Wood et al. Plug-in's are software components that extend the capabilities of a web browser to perform different functions such as setting-up a communication channel. The "plug-in" taught by Shachar would provide the Wood et al user with a convenient way to set-up the communication channel. Hundreds of plug-ins (software components) have been available for sale for many years.

With respect to claim 2, note that a PC (Col. 3, line 50) is used and that the phone (10) is a telephone.

With respect to claim 3, see Col. 3, lines 55 - 57.

With respect to claim 4, see Col. 3, lines 58 - 68.

With respect to claim 7, 13 and 19, note Fig. 1, and line 14 and 18. The reference teaches that either one or two telephone lines may be used. See also, Col. 3, lines 58 - 67 and Col. 6, lines 56 - 66.

With respect to claim 8, see the rejection of claim 1 and note the ability to enter search terms that correspond to telephone numbers (Col. 6, lines 32 - 34 and Fig. 3, element 68).

With respect to claim 9, note Col. 5, lines 62 - 65.

With respect to claim 11, note Col. 8, line 66 - Col. 9, line 14.

With respect to claims 12 and 16, if the system of Wood et al is integrated as taught at Col. 3, lines 55 - 57, then such steps are inherent.

With respect to claim 14, see the rejection of claims 1 and 8 above. In addition, the link syntax is the hypertext tag (Col. 5, lines 62 - 65).

Claim 15, is inherent from the discussions above.

With respect to claim 10, Wood et al and Shachar et al. teach the use of a hypertext tags as discussed above. However, Wood et al and Shachar et al. do not teach the tags as being "<dialto> telephone</dialto>". It would have been obvious to one of ordinary skill in the art to use any tag that was deemed appropriate to automatically dial a phone number.

With respect to claims 5 – 6 and 18, Wood et al teach the claimed device as discussed above except for the ability to disconnect from the web server upon dialing and then reestablishing the connection to the web server. However, Shachar et al teach that such a disconnect and reestablishment of the connection is old in the art (see abstract, Col. 8, lines 40 - 43 and Col. 10, line 54 - Col. 11, line 6). It would have been obvious to one of ordinary skill in the art to have incorporated the ability to disconnect from the web server upon dialing and then reestablishing the connection to the web server as taught by Shachar et al into the system and methods of Wood et al as an old means of convenience to a user.

(11) Response to Argument

The issue in this case is whether the Wood et al device has a plug-in, "connected" with said phone and said information terminal (web browser 12 in Wood et al., i.e., a computer) which can automatically dial a telephone number to set up a communication channel through a telephone 10 independent of a web server (web facility 22 in Wood et al.). Note that the elements in Fig. 2, particularly web server 34

are contained in web facility 22, see Col. 4, lines 49 - 52, therefore web facility 22 is the claimed "web server" and the "information terminal" web browser 12 in Wood et al.

Applicants seem to argue two things with respect to the plug-in. First is, that the plug-in in Wood et al. does not set up a communication channel through a telephone independent of a web server and the information terminal. Second, that there is no plug-in at all in the Wood et al. reference. Applicants were asked to compare page 6, lines 6 - 13 of the present application and Col. 6, line 56 - Col. 7, line 5 of Wood et al. There is no question that plug-in software exists in the Wood et al. reference. There is no difference between the present application and the Wood et al. reference with respect to a plug-in in which an automatic dialing operation carries out a program, which once the telephone number is displayed on web browser 12, the computer can dial the telephone number automatically after being selected.

With respect to the issue of whether Wood et al. can set up a communication channel through a telephone 10 independent of a web server 22 and an "information terminal", such is taught by Wood et al. One looking at Fig. 1 should understand that a communication channel through a telephone 10 independent of a web server 22 and an "information terminal" 12 is how the Wood et al. device operates. Wood et al. teach that a path 14 is a twisted pair (telephone line), path 18 is any suitable data communication path (separate from path 14, Col. 3, lines 46 - 49), and path 24, which connects web facility 22 to telephone switch 16, is X.25 or Ethernet path. When the subscriber uses telephone 10 and path 14 to make a phone call, this does not require, and operates independently from, web browser 12 and web facility 22. A normal phone

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call does not require the use of data path 18 or the X.25/Ethernet path 24. Wood et al. teach that after clicking on the DIAL button, web facility 22 sends a message to telephone switch 16 and then the switch sets up a call "in the same manner as if the number ... had been dialed by the subscriber at telephone 10." Again, there is absolutely no need to use web browser 12, data path 18, or X.25/Ethernet path 24 to set up the phone call. Thus, the phone call, in Wood et al., is set up independent of the web server and the web browser/"information terminal".

Claims 8 and 14, and their respective dependent claims, are rejected for similar reasons as set forth above with respect to claim 1.

For the above reasons, it is believed that the rejections should be sustained.


July 29, 2002

Conferees

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